

REMARKS/ARGUMENTS

Applicant thanks the Examiner for the telephone interview granted on June 25, 2005, in which Examiner and Applicant's attorney generally discussed potential claim amendments in light of the prior art. In addition, Applicant and Examiner discussed the rejection of Claim 5 under 35 U.S.C. § 103 in light of the Hasselbach reference (U.S. Patent No. 4,236,350) and whether the Hasselbach reference is analogous art.

Claim Amendments

Applicant has amended the claims simply to advance prosecution. Specifically, Applicant has canceled the previously pending claims and added new independent Claim 25 and new dependent Claims 26-43. Support for these claims is found throughout the specification.

Objection to Claim 21

The Examiner objected to Claim 21 because of an informality. Applicant has canceled Claim 21, rendering this objection moot.

Rejections under 35 U.S.C. Section 102(b)***The Hasselbach Reference***

The Examiner rejected Claims 1-4, 6-10, 12, 13, 15-17 and 21-24 under 35 U.S.C. 102(b) as being anticipated by the Hasselbach reference (U.S. Patent No. 4,236,350). Applicant has canceled these claims, rendering this rejection moot. Therefore, Applicant respectfully requests that this rejection be withdrawn.

The Artwick Reference

The Examiner also rejected Claims 1-4, 6, 12, 14 and 16-24 under 35 U.S.C. § 102(b) as being anticipated by the Artwick reference (Des 273,045). Applicant has canceled these claims, rendering this rejection moot. Therefore, Applicant respectfully requests that this rejection be withdrawn.

The Paganelli Reference

The Examiner rejected Claims 1-4 and 6-24 under 35 U.S.C. § 102(a) as being anticipated by the Paganelli reference (WO 92/02697). Applicant has canceled these claims, rendering this rejection moot. Therefore, Applicant respectfully requests that this rejection be withdrawn.

Rejections under 35 U.S.C. Section 103

The Hasselbach Reference

The Examiner rejected Claims 5 and 18 under 35 U.S.C. § 103 in view of the Hasselbach reference. Applicant has canceled Claim 18, rendering the rejection moot as to this claim, and respectfully requests withdrawal of the rejection as to Claim 18.

Applicant has also canceled Claim 5, rendering moot the Examiner's rejection as to this claim. Applicant, however, has added new Claim 25, which includes all of the limitations of Claim 5 but has the following preamble (with added language underlined): "A building skylight adapted to be attached to the roof of a building..."

According to MPEP § 2141.01 (a), "In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of

applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned.' (Citations omitted.)" In *In re Oetiker*, 977 F.2d 1443 (Fed. Cir. 1992), the Federal Circuit reversed a holding of the Board of Patent Appeals and Interferences, in which a claim had been rejected based on obviousness. The Federal Circuit held that it had not been shown that a fastener for garments was analogous to the claimed hose clamp fastener. In addition, the prior art reference describing the garment fastener provided no motivation to modify the nonanalogous art to arrive at the claimed invention.

Here, the additions to the preamble of Claim 25 emphasize that the claimed building skylight is adapted for attachment to a roof. In contrast, the cited Hasselbach reference discloses a seedling tray assembly comprising a base, a grid for planting seedlings and a cover. The seedling tray assembly of Hasselbach has neither the structure nor function of the building skylight of the Claim 25, as it is not adapted to be attached to the roof of a building but rather to hold seedlings in a manner that "...not only prevents over watering but also provides for substantially uniform distribution of water to the plants..." See column 1, lines 30-32 of the Hasselbach reference. The Hasselbach reference never mentions adapting the seed tray assembly to be used on a building. In short, the cited seed tray is at least as remote from the claimed skylight as the hose clamp fastener was from the garment fastener in the *Oetiker* case. Because Hasselbach is not an analogous reference, it should have no bearing on the patentability of Claim 25.

The Artwick Reference

The Examiner rejected Claims 7-10 under 35 U.S.C. § 103(a) as being obvious in light of the Artwick reference. Applicant has canceled these claims, rendering this objection moot. Therefore, Applicant respectfully requests withdrawal of this rejection.

Based on the foregoing amendments and remarks, Applicant respectfully submits that the application is now in condition for allowance.

Included with this communication is a request for continued examination, and a check to cover the small entity fee of \$395. Any additional fees required by this submission may be charged to deposit account 50-2767. If the Examiner has any questions regarding this communication or feels that an interview might facilitate prosecution of the application, he is invited to contact the undersigned at (916) 444-3900, x353.

Respectfully submitted,

Dated:

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